

This Opinion is Not a  
Precedent of the TTAB

Mailed: April 26, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Republic Technologies (NA), LLC*

*v.*

*Vapewear, Inc.*  
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Opposition No. 91253787  
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Antony J. McShane, Lee Barrington Stark and Andrew S. Fraker of Neal, Gerber & Eisenberg, LLP, for Republic Technologies (NA), LLC.

Michael A. Willner, Esq., for Vapewear, Inc.  
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Before Lykos, Lynch and Hudis,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Vapewear, Inc. (“Applicant”) seeks to register on the Principal Register the standard character mark NOJOKE for:

Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form, other than essential oils, used to refill electronic cigarette cartridges; Electronic cigarettes and oral vaporizers for smokers in International Class 39.<sup>1</sup>

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<sup>1</sup> Application Serial No. 88608744 was filed September 8, 2019, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce. Applicant’s mark appears on the drawing page as “NoJoke” but retains a claim as to standard characters and not special form. The presentation of the mark on the drawing page does not change the nature of the mark from a standard character mark to a special form mark. *See*

Republic Technologies (NA), LLC (“Opposer”) opposes registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on its previously used and registered JOKER marks for cigarette rolling papers. Opposer pleads ownership of the following registered marks, both issued on the Principal Register for “cigarette paper” in International Class 34:

Registration No. 1087438 for the stylized mark displayed below, registered on March 14, 1978 and renewed. The drawing is lined for the colors blue and red.



Registration No. 2661926 for the composite mark displayed below, registered on December 17, 2002 and renewed.



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Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a) (setting forth requirements for standard character mark). *See also In re Calphalon Corp.*, 122 USPQ2d 1153, 1158-61 (TTAB 2017) (applicant’s amendment of mark from SHARPIN to SharpIn did not transform mark from standard character to special form). For ease of reference, we refer to Applicant’s mark as NOJOKE throughout our opinion.

Citations to the record throughout the decision include references to TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

Opposer submitted copies of its registrations from the USPTO's Trademark Electronic Search System ("TESS") database with its Notice of Opposition pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1).

In its Answer, Applicant denied the salient allegations of the Notice of Opposition, and asserted various "affirmative defenses" that the Board construes as amplifications of its denials.<sup>2</sup> Although it is permissible to amplify a denial of, for example, an allegation of a likelihood of confusion in a pleading, *see Morgan Creek Prods., Inc. v. Foria Int'l, Inc.*, 91 USPQ2d 1134, 1135-36 (TTAB 2009), such amplifications are not, and should not be pled as, separate "defenses," and we do not treat them as such here. *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, \*4 n. 5 (TTAB 2021).

The case is fully briefed. Opposer, as plaintiff in this proceeding, bears the burden of establishing its statutory entitlement to a cause of action and Section 2(d) claim by a preponderance of the evidence. *See Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007). For the reasons explained below, we dismiss the opposition.

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<sup>2</sup> 4 TTABVUE 5. In addition, Applicant asserted the affirmative defense of failure to state a claim upon which relief may be granted. Insofar as Applicant neither filed a formal motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6) during the interlocutory phase of this proceeding, nor argued this asserted affirmative defense in its brief, it is hereby deemed waived. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (respondent's affirmative defense of failure to state a claim not argued in brief deemed waived), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.).

Further, Applicant's "attempt [in its Answer] to reserve the right to add defenses is improper under the Federal Rules of Civil Procedure, because that would not give ... [Opposer] fair notice of such defenses." *Philanthropist.com, Inc. v. Gen. Conf. Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, \*4 n.6 (TTAB 2021); *see also FDIC v. Mahajan*, 923 F. Supp. 2d 1133, 1141 (N.D. Ill. 2013) ("[A]ffirmative defenses that purport to reserve the right to add affirmative defenses at a later date ... are stricken because they are improper reservations under the Federal Rules.").

## **I. The Record**

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's NOJOKE application file.

### **A. Opposer's Main Trial Period**

Opposer made of record the testimony declaration of Sachin Lele, Vice President-Legal of Opposer and its distributor Republic Tobacco, L.P., with attached exhibits consisting of promotional materials for Opposer's JOKER branded cigarette papers such as posters, point-of-sale displays, and flyers (17 TTABVUE).<sup>3</sup> Opposer also introduced under notices of reliance the entire transcript of the Fed. R. Civ. P. 30(b)(6) discovery deposition of Michael Willner, Applicant's President, with exhibits (13 TTABVUE); Internet materials consisting of printouts from third-party e-commerce websites and retailers, periodicals, and trade publications (14 TTABVUE); third-party registrations printed from the TESS database (15 TTABVUE); and Applicant's Answers, Supplemental Answers, and Second Set of Supplemental Answers to Opposer's First Set of Interrogatories (16 TTABVUE).

### **B. Applicant's Trial Period**

Applicant submitted the testimony declaration of Mr. Willner, with attached exhibits consisting of sample product packaging of Applicant's e-liquid and Opposer's cigarette papers (19 TTABVUE). Applicant also introduced under notice of reliance

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<sup>3</sup> Opposer's submission of printouts of its pleaded registrations as exhibits to the Lele Declaration from the TESS database was superfluous insofar as Opposer properly made the registrations of record with its notice of opposition.

Opposer's Answers to Applicant's First Set of Interrogatories (18 TTABVUE).

### **C. Opposer's Rebuttal Trial Period**

During its rebuttal trial period, Opposer did not introduce any evidence.

## **II. Entitlement to a Statutory Cause of Action**

As a threshold issue, Opposer must prove entitlement to a statutory cause of action.<sup>4</sup> *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). According to Section 13(a) of the Trademark Act, 15 U.S.C. § 1063(a):

Any person who believes that he would be damaged by the registration of a mark upon the principal register, ... may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered.

To establish entitlement to a statutory cause of action under Section 13(a) of the Trademark Act, Opposer must demonstrate (1) that it is within the zone of interests protected by the statute (i.e., has a "real interest" in the outcome of the proceeding) and (2) damage proximately caused by registration (i.e., a reasonable basis for its belief in damage). *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*4-8 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian*

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<sup>4</sup> Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." Mindful of the Supreme Court's direction in *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014), we now refer to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 of the Trademark Act remain equally applicable. *See, e.g., Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at \*10 n.39 (TTAB 2021) (citing *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at \*2 (TTAB 2020)).

*Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *see also Empresa*, 111 USPQ2d 1162. *See also Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999) (defining a “real interest” as a “direct and personal stake” in the outcome of the proceeding).

Opposer properly made of record with its Notice of Opposition its pleaded Registrations Nos. 1087438 and 2661926 from the USPTO’s TESS database showing their current status and title.<sup>5</sup> *See* Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1). Opposer has therefore demonstrated that it possesses a real interest in this proceeding beyond that of a mere intermeddler, and a reasonable basis for its belief of damage. *See Ritchie*, 50 USPQ2d at 1026; *see also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 190 (CCPA 1982). We find, therefore, that Opposer has proven its entitlement to bring the instant proceeding.

### **III. Section 2(d) Claim**

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

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<sup>51</sup> TTABVUE 10-13.

Thus, Opposer must prove both priority and likelihood of confusion by a preponderance of the evidence in order to prevail

### **A. Priority**

Because, as noted above, Opposer properly made of record its valid and subsisting pleaded registrations and Applicant did not counterclaim to cancel them, priority is not at issue for the marks and the goods identified in each individual registration vis-à-vis the opposed goods in the application. *See King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). *See also Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012).

### **B. Likelihood of Confusion**

We now consider the remaining element of Opposer's Section 2(d) claim, likelihood of confusion. Our analysis is based on all of the probative evidence of record. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In making our determination, the Board has considered each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed.

Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). These factors, and the other *DuPont* factors argued by each party, are discussed below.

### **1. The Similarity or Dissimilarity of the Marks**

This *DuPont* factor involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 577). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, (Fed. Cir. Sept. 13, 2019). *Accord, Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection

between the parties.” *Coach Servs.*, 101 USPQ2d at 1721 (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975)). Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). “On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 224 USPQ at 751.

Opposer argues that the shared element JOKE makes the marks similar in appearance and sound and is central to each mark’s meaning and commercial impressions. Opposer contends that “the marks approach the theme of a joke from

different directions – JOKER in the affirmative and NOJOKE in the negative – but both call to mind the same concept,” thereby rendering the marks “associative terms.”<sup>6</sup> In support thereof, Opposer cites to the principle that marks composed of “associative terms” may create similar commercial impressions such that consumers would be likely to assume that the products offered under them emanate from the same source “or are, in some way, affiliated therewith.”<sup>7</sup> *See, e.g., Downtowner Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105 (TTAB 1973) (UPTOWNER and DOWNTOWNER, each for motels, were confusingly similar because “up and down are associative terms in that one word creates the image or idea of the other.”). In Opposer’s view, consumers are likely to view Applicant’s NOJOKE mark as affiliated with Opposer’s JOKER marks, with consumers perceiving Applicant’s mark as a product line extension.

Opposer’s arguments amount to an improper dissection of the marks. While both marks incorporate formatives of the word “joke,” the similarities stop there. Comparing the marks as a whole, we find them to be dissimilar, especially in connotation and commercial impression, and also in sound and appearance. *See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing Board’s holding that contemporaneous use of THE RITZ KIDS for clothing items, including gloves, and RITZ for various kitchen textiles, including barbeque mitts, is likely to cause confusion, because THE RITZ KIDS creates a

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<sup>6</sup> Opposer’s Brief, p. 15; 20 TTABVUE 21.

<sup>7</sup> *Id.*

different commercial impression).

Applicant's and Opposer's marks have markedly different connotations and commercial impressions. NOJOKE is a recognized expression that emphasizes the truthfulness of something potentially unbelievable, and communicates an air of seriousness. By contrast, Opposer's stylized and composite JOKER marks convey the impression of a court jester, a comic foolish clown. Thus, despite their common associative term, the meanings of these marks and the impressions they give share no similarity.

Applicant's mark NOJOKE differs visually from Opposer's single word mark **JOKER** in stylized form as well as the composite mark below:



Applicant's mark is a phrase commencing with the word "no" used as a modifier to the noun "joke." Opposer's marks, by contrast, are comprised either of the single stylized word "joker" or the word displayed twice in small print relative to the depiction of a whimsical court jester. This distinction is important since "it is often the first part of a mark which is likely to be impressed upon the mind of a purchaser and remembered." *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897

(TTAB 1988). *See also Palm Bay*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark). This is particularly true here, where consumers would notice the “no” as the first part of the “no joke” expression they would readily recognize. With regard to Opposer’s composite mark, the prominent design of a joker or court jester “catches the eye” and stands out as a significant feature. *See Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1016 (TTAB 2007) (“...the design is very noticeable and has the effect of catching the eye and engaging the viewer before the viewer looks at the word BODYMAN.”). The whimsical distinct design features of Opposer’s composite mark are dominant and further avoid a likelihood of confusion. “While it is often true that the words in a composite word and design mark are considered to be dominant, that is not always the case.” *In re Covalinski*, 113 USPQ2d 1166, 1168 (TTAB 2014). Apart from the visual differences, the marks also do not sound alike. NOJOKE will be pronounced by consumers as a two-word phrase commencing with the word “no,” whereas Opposer’s marks will be pronounced as the single word JOKER.

We find that the marks, when considered in their entireties, are dissimilar in appearance, sound, and connotation, and commercial impressions. Accordingly, this *DuPont* factor weighs against finding a likelihood of confusion.

## **2. Fame or Commercial Strength of Opposer’s JOKER Marks**

Fame, when present, plays a dominant role in a likelihood of confusion analysis because of the broad scope of protection afforded famous or commercially strong marks. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305

(Fed. Cir. 2002); *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). *See also DuPont*, 177 USPQ at 567 (the fifth *DuPont* factor is “[t]he fame of the prior mark (sales, advertising, length of use).” Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs.*, 101 USPQ2d at 1720 (citing *Leading Jewelers Guild*, 82 USPQ2d at 1904).

A mark’s commercial strength or fame is not a binary factor in the context of a likelihood of confusion analysis. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (“The TTAB applied a legally incorrect standard in applying an all-or-nothing measure of ‘fame,’ more akin to dilution analysis.”). Rather, likelihood of confusion fame “varies along a spectrum from very strong to very weak.” *Palm Bay*, 73 USPQ2d at 1694 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003)). In addition, fame for likelihood of confusion purposes arises only so long as a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Palm Bay*, 73 USPQ2d at 1694.

Fame for likelihood of confusion purposes may be measured directly by consumer surveys or indirectly by the volume of sales and advertising expenditures of the goods sold under the mark, for example, and other factors such as length of time of use of the mark; wide-spread critical assessments; notice by independent sources of the

products identified by the marks; and the general reputation of the products or services. *Bose*, 63 USPQ2d at 1308; *see also Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689-90 (Fed. Cir. 2018) (indirect indicia of fame may include “the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident”) (quoting *Bose*); *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351 (TTAB 2014), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014).

Given the nature of Opposer's goods, special considerations apply when analyzing the fame or commercial strength of its registered JOKER marks. As with all tobacco products, federal law limits the advertising of cigarette paper. The Public Health Cigarette Smoking Act of 1969 bans the advertising of cigarettes and related goods on television and radio, *see* Pub. L. 91-222; 15 U.S.C. § 1335, and targeting youths. *See* 21 C.F.R. § 1140 *et seq.* The 1997 Tobacco Master Settlement Agreement between the Attorneys General of the 46 settling States and participating manufacturers of tobacco products further restricts marketing activities by prohibiting outdoor advertising such as on billboards and public transportation. Opposer and its distributor comply with these restrictions in marketing its product.<sup>8</sup> Keeping these restrictions on advertising in mind, we assess the fame or commercial strength of the JOKER marks.

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<sup>8</sup> Lele Decl. ¶ 22; 17 TTABVUE 10.

Opposer contends that with over four decades of use, its JOKER marks have garnered “a significant amount of consumer recognition and goodwill.”<sup>9</sup> According to the record, Opposer, through its predecessor in interest, has been selling JOKER branded cigarette papers in interstate commerce since 1975 and presently offers its goods in over 50,000 convenience stores, gas stations, mini marts, tobacco stores and outlets, mass merchandisers, cash and carry outlets, and other retail locations.<sup>10</sup> JOKER cigarette papers are also available for sale online, through retailer websites as well as third-party online retailers such as Amazon and Alibaba.<sup>11</sup> Opposer further maintains that through its distributor, it extensively advertises cigarette papers in connection with the JOKER marks to wholesalers and retailers at trade shows and through monthly promotional fliers, fact sheets and other promotional material and price lists delivered to actual and potential retailer customers.<sup>12</sup> Consistent with the guidelines under federal law, for retailers generally open to people of all ages, such as convenience or drug stores, advertisements are restricted to “point-of-sale” promotional materials,<sup>13</sup> such as JOKER cigarette papers in booklets bearing the JOKER word mark.<sup>14</sup> These booklets are contained in boxes designed to be opened and folded by consumers in such a way as to emphasize the JOKER word and design

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<sup>9</sup> Lele Decl. ¶ 11; 17 TTABVUE 7.

<sup>10</sup> *Id.* at ¶ 16; 17 TTABVUE 9.

<sup>11</sup> *Id.*

<sup>12</sup> *Id.* at ¶ 13; 17 TTABVUE 7.

<sup>13</sup> *Id.*

<sup>14</sup> *Id.*

marks to consumers.<sup>15</sup> Similarly, the bowls, typically located on the counter of retail stores, have collars that also highlight the JOKER marks.<sup>16</sup> Other point-of-sale promotional materials include posters and counter mats, which are used to promote the JOKER brand.<sup>17</sup>

While we appreciate the extent of Opposer's marketing efforts within the parameters of federal law, we are unable to find that Opposer's JOKER marks fall on the high end of the spectrum of fame or strength. Given the legal restrictions on advertising, we would not expect to find the same level of consumer exposure or advertising expenditures as we would with non-tobacco products. This of course heightens the importance of other indicia of fame or commercial strength. Here, however, the record is devoid of annual U.S. sales or advertising figures for Opposer's "cigarette papers" sold either by Opposer or its exclusive distributor under the JOKER marks. For these reasons, we find that Opposer's registered JOKER marks fall on the lower end of the fame or commercial strength spectrum. Thus, while Opposer's JOKER marks may enjoy some degree of recognition, its commercial strength or fame is relatively modest.

Opposer also argues that because its JOKER marks are arbitrary in connection with the goods, they are inherently strong. We agree that Opposer's marks are inherently distinctive as evidenced by its registration on the Principal Register

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<sup>15</sup> *Id.*

<sup>16</sup> *Id.*

<sup>17</sup> *Id.*

without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. *Tea Bd. of India v. The Republic of Tea, Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006). Opposer's registration is "prima facie evidence of the validity of the registered mark ..." Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *See also Tea Bd. of India*, 80 USPQ2d at 1899. We therefore accord Opposer's JOKER marks "the normal scope of protection to which inherently distinctive marks are entitled." *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017).

### **3. The Goods**

Next, we compare the goods as they are identified in the involved application and Opposer's registration. *See Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *Stone Lion*, 110 USPQ2d at 1161; *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). The goods need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that the goods emanate from the same source." *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). The issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830, 831

(TTAB 1984).

Opposer argues that the parties' goods are inherently related because they fall under the category of "tobacco products" as defined by the Food and Drug Administration, and use by electronic cigarette consumers of tobacco products such as cigarette paper.<sup>18</sup> Applicant counters that its electronic cigarettes, e-liquids, and oral vaporizers are distinguishable because they are designed to help smokers, particularly drivers who smoke, quit smoking by switching to what Applicant characterizes as a "healthier alternative."<sup>19</sup> Applicant describes some of its goods as a combination watch and wearable vape:

For truckers and other drivers, a wearable vape eliminates the need to take their eyes off the road to reach for and grab a cigarette pack, extract a cigarette, place it in their mouth, and hold it there or between their fingers between puffs. By switching to the vWatch, not only can they avoid inhaling the carcinogens in a combustible cigarette, but they would also avoid having to hold anything other than the steering wheel between puffs while keeping their eyes on the road.<sup>20</sup>

As noted above, however, Applicant's goods are identified without any restrictions as to purpose or use. For example, nothing in the identification of Applicant's electronic cigarettes and oral vaporizers for smokers indicates that they are wearable or consist only of wearable watches. As such, we must assume that Applicant's e-cigarettes

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<sup>18</sup> See Lele Decl. ¶ 19; 17 TTABVUE 9.

<sup>19</sup> Applicant's Brief, p. 5; 21 TTABVUE 6. The Board denies Applicant's request to take judicial notice of the CDC publication "About Electronic Cigarettes", [https://www.cdc.gov/tobacco/basic\\_information/e-cigarettes/about-e-cigarettes.html](https://www.cdc.gov/tobacco/basic_information/e-cigarettes/about-e-cigarettes.html) on the ground that this purported fact is subject to reasonable dispute. See Fed. R. Evid. 201, made applicable to Board proceedings by way of Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a).

<sup>20</sup> Applicant's Brief, p. 5; 21 TTABVUE 6.

include all types, including the more traditional type that is not wearable or embedded within a watch. *See S.W. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”).

With this in mind, the record demonstrates that Applicant’s and Opposer’s goods are in fact related. Opposer submitted evidence from the following third-party tobacco product retailers:

X-Treme Smoke and Vapor offers for sale electronic cigarettes and “smoking papers.”<sup>21</sup>

Prime Wholesale.com offers for “rolling papers” and electronic cigarettes.<sup>22</sup>

Big Lake Smoke Shop sale disposable electronic cigarettes and “rolling papers.”<sup>23</sup>

Vapers and Papers.com offers for sale disposable e-cigarettes, e-liquids, and “rolling paper.”<sup>24</sup>

Randy’s offers for sale vaporizers and “rolling paper.”<sup>25</sup>

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<sup>21</sup> Opposer’s Notice of Reliance, 14 TTABVUE 16.

<sup>22</sup> *Id.* at 76-78.

<sup>23</sup> *Id.* at 85-89.

<sup>24</sup> *Id.* at 92-93.

<sup>25</sup> *Id.* at 123.

1 Percent offers for sale vaporizers and “rolling paper.”<sup>26</sup>

Hippie Butler offers for sale vaporizers and “rolling papers.”<sup>27</sup>

Mil-Spec Packaging offers for sale corrugated boxes and paper tubes.<sup>28</sup>

Consumers therefore may expect to find Applicant’s “electronic” cigarettes and vaporizers and Opposer’s “cigarette papers” as identified in the involved application and registration emanating from a common source.<sup>29</sup> *See Detroit Athletic*, 128 USPQ2d at 1050 (crediting relatedness evidence that third parties use the same mark for the goods and services at issue because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (stating that evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”).

Opposer also submitted eighteen (18) use-based, valid and subsisting, third-party registrations, owned by different entities, showing Applicant’s “electronic cigarettes” and Opposer’s “cigarette papers” or the legal equivalent thereof.<sup>30</sup> *See* Registration

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<sup>26</sup> *Id.* at 129.

<sup>27</sup> *Id.* at 143.

<sup>28</sup> *Id.* at 34-38.

<sup>29</sup> The evidence shows that “rolling papers” are the same as “cigarette papers.”

<sup>30</sup> Just as we must consider the full scope of the goods as set forth in the application and registration under consideration, we must consider the full scope of the goods described in a third-party registration. *See Stone Lion*, 110 USPQ2d at 1161; *see also In re Country Oven, Inc.*, 2019 USPQ2d 443903, at \*5-6 (TTAB 2019) (the terms “bakery goods” and “bakery products” in third-party registrations were sufficiently broad to encompass “bread buns”). Some of the registrations are for “rolling papers” which is sufficiently broad to include “cigarette papers.”

Nos. 6376877, 6364395, 6354923, 6354714, 6334073, 6305705, 6311021, 6025475, 6132995, 6349385, 6317081, 6311639, 6295941, 6187678, 6164689, 6087244, 6037809, and 6244194.<sup>31</sup> As a general proposition, third-party registrations that cover goods from both Opposer's registration and an Applicant's application are relevant to show that the goods are of a type that may emanate from a single source under one mark. *See, e.g., Detroit Athletic*, 128 USPQ2d at 1051; *Hewlett-Packard*, 62 USPQ2d at 1004; *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *Albert Trostel & Sons*, 29 USPQ2d 1783,1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Opposer's testimony corroborates this finding and shows that the goods are complementary items. According to the Lele Declaration:

...many smokers also ingest tobacco by multiple means. For instance, consumers who roll their own cigarettes will also use a vaporizer or electronic cigarette, smoke a pipe or cigar or buy a pack of pre-made cigarettes. There are very few tobacco users who only use a single form of tobacco.<sup>32</sup>

Based on the foregoing, we find that Applicant's "electronic cigarettes" and "oral vaporizers," each designated for use "by smokers" are related to Opposer's "cigarette papers." *See Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found as to the entire class if there is likely to be confusion with respect to any item that comes within the identification of goods or services in that class). This *DuPont* factor weighs in favor of

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<sup>31</sup> Opposer's Notice of Reliance, 15 TTABVUE 6-53.

<sup>32</sup> Lele Decl. ¶ 19; 17 TTABVUE 9.

finding a likelihood of confusion.

#### **4. The Established, Likely-to-Continue Channels of Trade and Classes of Consumers**

Turning now to the established, likely-to-continue channels of trade and classes of consumers, because Applicant's and Opposer's identifications contain no restrictions as to channels of trade, or classes of purchasers, we must presume that the identified goods travel in the ordinary channels of trade for such goods. *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003). According to the record, Opposer sells its JOKER branded cigarette papers in all of the normal channels of trade for smokers' articles as permitted under federal law and the Master Settlement Agreement: brick and mortar retail outlets such as drug stores, convenience stores, gas stations, mini-marts, and stores specializing in tobacco and smoking products.<sup>33</sup> Applicant presented testimony that it intends to sell its products through the same channels,<sup>34</sup> because it views these channels as the most beneficial for its sales.<sup>35</sup> As part of its promotional efforts Applicant has already provided free samples of NOJOKE e-liquid to potential retailers and designed a point-of-sale display to convenience stores and gas stations.<sup>36</sup> We therefore find that the established, likely-to-continue channels of trade overlap.

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<sup>33</sup> Lele Decl. ¶ 16; 17 TTABVUE 8.

<sup>34</sup> Willner Dep. 53:8-54:23, 63:18-64:10 and 90:7-18; 13 TTABVUE 58-59, 68-69, 95.

<sup>35</sup> *Id.* at 63:16-21, 90:21- 91:20; 13 TTABVUE 68-69, 95.

<sup>36</sup> *Id.* at 49:7-50:7, 52:3-54:23; 13 TTABVUE 54-55, 58-59.

With regard to classes of consumers, Applicant argues that it intends to market its products to adult drivers seeking to quit smoking; Opposer by contrast targets young consumers. Applicant is impermissibly reading limitations into its own and Opposer's identifications of goods. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation here, and nothing in the inherent nature of SquirtCo's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The board, thus, improperly read limitations into the registration."). We reiterate that the identifications of goods in Opposer's registrations and Applicant's application contain no limitations as to age or activity (such as driving) Based on the Opposer's identification alone, we can conclude that Opposer's target market consists of consumers of cigarette papers ages 18 and over. We can draw the same conclusion based on the wording of Applicant's identification for "electronic cigarettes and oral vaporizers for smokers." Thus, consistent with the mandates of federal law, both Applicant and Opposer's targeted class of consumers are the same, consumers of smoking products of legal age.<sup>37</sup>

In view of the foregoing, the *DuPont* factor regarding the similarity or dissimilarity of established, likely-to-continue trade channels and classes of consumers favors a likelihood of confusion.

## **5. Purchasing Conditions**

Although we have concluded that the classes of purchasers are the same, we must also examine as argued by the parties the conditions under which the goods are likely

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<sup>37</sup> Lele Decl. ¶ 18; 17 TTABVUE 9 and Willner Dep. 93:9- 94:3, 94:9-12; 13 TTABVUE 98-100.

to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. *Top Tobacco, L.P. v. North Atl. Op. Co., Inc.*, 101 USPQ2d 1163, 1170 (TTAB 2011). A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay*, 73 USPQ2d at 1695.

Opposer contends the parties' goods are relatively inexpensive and may be purchased by ordinary consumers at convenience stores, drug stores, gas stations, mini-marts and similar outlets.<sup>38</sup> Although the application is based on intent to use the NOJOKE mark in commerce, the record shows that a fruit-flavored e-liquid bearing the mark was available for purchase on Applicant's website for approximately three months in late 2019 and early 2020, at a price point of \$18.99 for a pack of four pods of e-liquid.<sup>39</sup> Opposer contends that in these retail environments, consumers are unlikely to significant care in making their purchases, and in fact may buy items on impulse.

Applicant questions the assumption that \$18.99 for four pods of e-liquid is inexpensive: "[W]hoever thinks a 8 4-pod pack of e-liquid sold in a convenience store for \$18.99 is relatively low-priced and "subject to impulse buying" by someone buying

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<sup>38</sup> Lele Decl. ¶ 9, 17 TTABVUE 6; Willner Dep. 53:8-54:23, 90:7-18, 13 TTABVUE 58-59, 95.

<sup>39</sup> *Id.* at 56:18-57:23 and Exs. 7-8; 13 TTABVUE 61-62 and 175-179.

a \$0.99 pack of rolling papers, doesn't relate to the average consumer. If anything is an impulse buy, it's the rolling papers for a dollar, not the e-liquid for almost \$20.”<sup>40</sup>

The Board has previously found that the degree of sophistication exercised in purchasing tobacco products varies proportionately to the cost of the product. *See Top Tobacco*, 101 USPQ2d at 1171. We do not have any evidence in the record regarding the price point of Applicant's electronic cigarettes. However, even if we assume that they will be sold at retail at the same price as the e-liquids (i.e. significantly higher relative to cigarette papers), at these low to moderate prices, adult purchasers of the parties' products are likely to exercise ordinary care. *See Recot*, 54 USPQ2d at 1899; *see also In re Davia*, 110 USPQ2d at 1818 (“Generally, casual purchasers of low-cost, every-day consumer items exercise less care in their purchasing decisions and are more likely to be confused as to the source of the goods.”). Accordingly, this factor is neutral. .

## **6. Bad Faith**

The final relevant *DuPont* factor in this case is Applicant's intent in choosing the mark NOJOKE, and whether it reflects a bad-faith attempt to trade on Opposer's goodwill in its JOKER mark. *See, e.g., J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) (“Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered[.]”). Establishing bad faith requires a showing that the applicant intentionally sought to

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<sup>40</sup> Applicant's Brief, pp. 15-16; 21 TTABVue 16-17.

trade on the opposer's good will or reputation. *See Big Blue Prods. Inc. v. Int'l Business Machines Corp.*, 19 USPQ2d 1072, 1076 (TTAB 1991).

Opposer cites the testimony of Applicant's President, Mr. Willner, that he has been aware of JOKER branded cigarette papers for "many years from seeing them at convenience stores" possibly even "decades,"<sup>41</sup> as well as Applicant's trademark search for potentially conflicting marks limited to the exact term NOJOKE<sup>42</sup> as evidence of bad faith. Opposer points to the fact that Applicant's searches apparently did not include variants of the word "joke" such as "joker" despite Mr. Willner's testimony that it was aware of the JOKER marks. Opposer also faults Applicant for not seeking the advice of intellectual property counsel.<sup>43</sup>

An applicant's prior knowledge of an opposer or its marks is not, in itself, sufficient to constitute bad intent. *See Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another's mark or even an intent to copy. *See Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) ("[T]he 'only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.'" (quoting McCarthy, T.J., MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:113)). The record shows that Applicant selected the

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<sup>41</sup> Applicant's Answer to Int. No. 11, 16 TTABVUE 10; Willner Dep. 103:22-104:12, 104:20-24, 13 TTABVUE 108-109.

<sup>42</sup> *Id.* at 73:13-74:6; 13 TTABVUE 78-79.

<sup>43</sup> *Id.* at 75:11-22, 103:7-20; 13 TTABVUE 80, 108.

mark NOJOKE because “Applicant’s stakeholders liked it.”<sup>44</sup> This sentiment is devoid of bad faith. Likewise, Applicant’s limited trademark search for potentially confusing marks does not support an inference of bad faith. Even if a more comprehensive search for variations of the word “joke” would have disclosed Opposer’s registered marks, mere awareness would not establish bad faith. *Quicktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 USPQ2d 35, at \*4 (Fed. Cir. 2021).

Simply put, the evidence of record is insufficient to support a finding of bad faith, i.e. intent to confuse. Accordingly, we find this *DuPont* factor is neutral.

### **7. Balancing the *DuPont* Factors**

Any of the *DuPont* factors may play a dominant role. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. In fact, in some cases, a single factor (such as the differences in the marks) may be dispositive. *Kellogg Co. v. Pack’em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). We find that to be the case here. Although we find that the goods are related and sold in overlapping established, likely-to-continue channels of trade to the same class of consumers exercising only ordinary care, these are outweighed by the dissimilarity of the marks. The remaining factors discussed above are neutral. For that reason, we find the first *DuPont* factor to be pivotal, and that confusion is unlikely. *See, e.g., Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1461 (Fed. Cir. 1998) (court affirms Board dismissal of opposition based on dissimilarity of the marks CRISTAL and CRYSTAL CREEK); *Kellogg Co. v. Pack’em*, 21 USPQ2d at 1142 (court

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<sup>44</sup> Applicant’s Response to Opposer’s Interrogatory No. 2; 16 TTABVUE 7.

affirms Board dismissal of opposition based on dissimilarity of the marks FROOTEE ICE and elephant design and FRUIT LOOPS); *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 9 USPQ2d 1736, 1739-40 (Fed. Cir. 1989) (court affirms Board dismissal of opposition based on dissimilarity of the marks PECAN SANDIES and PECAN SHORTEES in commercial impression). In reaching this conclusion, we have carefully considered all of the evidence pertaining to the relevant *DuPont* factors, as well as all of the parties' arguments with respect thereto. "No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark." *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010).

Although Opposer has proved its entitlement to a statutory cause of action and priority by a preponderance of the evidence, it failed to prove likelihood of confusion, a key element of its Section 2(d) claim.

**Decision:** The opposition is dismissed.